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EXAMINER

GRAYSAY, TAMARA L

ART UNIT PAPER NUMBER

3623

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/767,438

Applicant(s)

WALKER ET AL.

Examiner

Tamara L. Graysay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Priority*

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

- a. In accordance with MPEP § 201.11.III.C, “A nonprovisional application that directly claims the benefit of a provisional application under 35 U.S.C. 119(e) must be filed within 12 months from the filing date of the provisional application.” Applicant is attempting to claim the benefit of three prior filed provisional application under 35 U.S.C. 119(e). The current application was filed more than 12 months after the filing of each provisional application (60/045436, 60/081369, and 60/081896).
- b. If a benefit claim to a provisional application is submitted without an indication that an intermediate application directly claims the benefit of the provisional application and the instant nonprovisional application is not filed within the 12 month period or the relationship between each nonprovisional application is not indicated, the Office will not recognize such benefit claim. MPEP § 201.11.III.C.
- c. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

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2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

- a. MPEP § 201.11.III.C reads, “A benefit claim that merely states “this application claims the benefit of nonprovisional Application Nos. C and B, and provisional Application No. A” would be improper.”

The benefit claim in the current application is improper. It reads in-part, “This application claims the benefit of prior filed copending Patent Application No. 09/071,928 filed on May 1, 1998, [Attorney Docket No. 725-1], prior filed copending Patent Application No. 09/060,855 filed on April 15, 1998, [Attorney Docket No. 725-2], prior filed copending Patent Application 09/292,511 filed on April 15, 1999, [Attorney Docket No. 725-6] prior filed Provisional Application No. 60/045,436 filed on May 2, 1997, \* prior filed Provisional Application No. 60/081,369 filed on April 10, 1998, and prior filed Provisional Application No. 60/081,896 filed on April 15, 1998, ...” (\*repetitive information omitted)

- b. This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required.

The benefit claim at the first sentence of the specification lists three prior nonprovisional applications. The current application was not copending with two of the prior nonprovisional applications (09/060855 and 09/071928).

- c. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the

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specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

The current application was copending with prior nonprovisional application 09/292511; however, the specific reference to the prior application lacks the relationship of the current application to the prior application.

d. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

3. If applicant desires priority under 35 U.S.C. 119(e) and 120 based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression “now Patent No. \_\_\_\_\_” should follow the filing date of the

parent application. If a parent application has become abandoned, the expression “now abandoned” should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was

unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

***Information Disclosure Statement***

4. The listing of references in the specification (at P.4-P.5) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

***Oath/Declaration***

5. The Office no longer checks the date of execution of the declaration. In accordance with MPEP § 602.05, applicants are reminded that they have a continuing duty of disclosure under 37 CFR 1.56.

***Drawings***

6. The drawings are objected to because:
- a. Within the lower left block of Fig.1, the term "seta" should be --sets--.
  - b. Fig.1 includes an improper floating block at the top half. The block should be associated with the figure. If the floating block depicts a modified form of the invention, it must be shown in a separate figure, as required by 37 CFR 1.84(h)(5).
  - c. If the block diagram of Fig.1 depicts a flow diagram, then arrowed connectors should be used between the blocks.

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- d. Fig.2 includes an improper floating block at the top right quadrant. If the floating block depicts a modified form of the invention, it must be shown in a separate figure, as required by 37 CFR 1.84(h)(5).
- e. If the block diagram of Fig.2 depicts a flow diagram, then arrowed connectors should be used between the blocks.
- f. Within the lower block of Fig.3, the term “nest” should be --next--.
- g. If the block diagram of Fig.3 depicts a flow diagram, then arrowed connectors should be used between the blocks.
- h. Fig.4 includes two improper floating blocks at the lower half. If the floating block(s) depicts a modified form of the invention, it must be shown in a separate figure, as required by 37 CFR 1.84(h)(5).
- i. If the block diagram of Fig.4 depicts a flow diagram, then arrowed connectors should be used between the blocks.
- j. If the block diagram of Fig.5 depicts a flow diagram, then arrowed connectors should be used between the blocks.
- k. In accordance with 37 CFR 1.84(u), view numbers must be preceded by the abbreviation “FIG.” Numbers and letters identifying the views must be simple and clear. The view numbers must be larger than the numbers used for reference characters. The numbers identifying the Fig.1-7 views are not clear and are too small.
- l. The text within the figures is too small. 37 CFR 1.84(p)(3) requires reference characters to be at least 1/8 inch.



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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

7. The disclosure is objected to because of the following informalities:
  - a. P.4, L.3, “stored or magnetic” should be --stored on magnetic-- (note P.4, L.5).
  - b. P.4, L.10, “5,855,522” appears to be an error because the cited patent is for a golf putting device. Perhaps it should be --5,844, 522--.
  - c. P.8, L.19, “preferable” should be --preferably--.
  - d. P.11, L.2, the term “OASIS” is used. If the term is an acronym, the definition should be included in the specification. If the term is a trademark, it should be capitalized wherever it appears and be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

e. P.11, L.11, "identify" should be --identity--.

f. P.11, L.18-19, the written description of Fig.6 and Fig.7 is not a detailed description of the elements contained in the drawing figures.

Appropriate correction is required.

8. The use of the trademark Hot-Sync has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

The use of the trademark Oracle has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

The use of the trademark GPS has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The subject matter recited in claims 19-41 must be described in the specification.

10. The attempt to incorporate "essential material" into this application by reference:

- a. to U.S. Patent Applications 09/071928, 60/045436, 60/081369, and 60/081896 is improper because the applications are not pending U.S. applications;
- b. to U.S. Patent Application 09/292511 is improper because the application is not pending; however, applicant may incorporate "essential material" by reference U.S. Patent 6591242 so long as the patent does not itself incorporate "essential material" by reference; and
- c. to U.S. Patent Application 09/060855 is improper because the application is not pending; however, applicant may incorporate "essential material" by reference to U.S. Patent 6154727 so long as the patent does not itself incorporate "essential material" by reference.

"Essential material" is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 U.S.C. 112). The instant application does not describe the claimed invention as recited in claims 19-41. An application for a patent when filed may incorporate "essential material" by reference to (1) a U.S. patent, (2) a U.S. patent application publication, or, subject to some conditions, (3) a pending U.S. application.

11. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should

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include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

***Claim Rejections - 35 USC § 112, first paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not include sufficient disclosure of the invention's structure that enables performance of the functions depicted in the block diagrams. The elements of the

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computer are not described, only the functions of the programmed software. One skilled in the art would not be able to make and/or use the invention, as claimed, without undue experimentation because the elements and their interrelationships are not described in hardware or hardware and its associated software. See *In re Scarbrough*, 182 USPQ 298, 301-02 (CCPA 1974). The structure represented by the block diagrams is not disclosed as conventional structure that can be determined without undue experimentation. See *In re Donohue*, 193 USPQ 136, 137 (CCPA 1977).

Further, the disclosure must constitute more than a bare group of programs with reference to a proprietary computer on which they might be run. MPEP § 2106.V.B.2; see *In re Knowlton*, 178 USPQ 486, 493 (CCPA 1973). In the instant application, the disclosure merely refers to three alternative computers on which the group of programs may be run. For example, the disclosure is not clear as to how the proprietary computer structure runs the program that assigns an individual provider to perform service at a site or how the program determines which provider is assigned to perform the service (see Fig.2, top block, "TSP assigns a field staff member to visit the patient").

***Claim Rejections - 35 USC § 112, second paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 6, 7, 8, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 6 contains the trademark/trade name Hot-Sync. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a computer to database connection and, accordingly, the identification/description is indefinite.

b. Claim 7 is indefinite because it recites a wireless connection, however, claim 6 which it depends upon, recites a wired connection. It is not clear whether claim 7 is drawn to a wired connection or a wireless connection, i.e., whether the information is provided to the computer via a wired or wireless connection. The metes and bounds of claim 7 are not clear since claim 7 does not appear to further limit the claim upon which it depends.

c. Claim 8 contains the trademark/trade name GPS. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of

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goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a computer to database connection and, accordingly, the identification/description is indefinite.

d. Claim 42, the recitation of “combined means” followed by the recitation of ten functions is not clear whether each of the recited functions are included in the scope of the claim or only some of the recited functions. Is the “combined means” the same as the carryable computer recited previously in the claim? If so, the elements should be related to each other. Applicant must clarify whether the structure to perform each of the recited functions is included in the “combined means” of the claim, e.g., what the “combined means” comprises. Although other means-plus-function language is recited within the claim, the use of the term “combined means” is confusing as to the metes and bounds of patent protection sought.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-5, 8-13, 17, 19-25, 33, and 38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sussman (US-4961158) in view of Katz (US-5963912).

a. Regarding claim 1, paragraph (k), the recitation “the performed service information” has been interpreted as the previously recited fourth information; paragraph

(k) the recitation “data and information previously stored” has been interpreted as the previously recited first information.

Sussman discloses a method including the steps of receiving a request for service (client task C.2, L.16); establishing on a relational database an account associated with the request (client table Ref.RAM3 10 and task table RAM2 9 and data table RAM1 8); assigning an individual provider to perform service (Sussman discloses that the portable device may be used by salespeople who sell services or professional people) and entering first information about the provider (Sussman discloses input of information about the provider for example the salesperson or professional cost per hour) into the relational database (table maintenance program C.9, L.52-67); providing, to a carryable computer associated with the provider (the salesperson or professional carries the device), second information, associated with the site (client telephone number and/or address C.3, L.65-68), and third information, required to render the service (client task data table RAM2 9), causing the computer to store the date and/or time data when the provider arrives at the site (data table RAM1 8 / date time field Ref.37 is automatically updated and transactions are stamped with the date C.10, L.55-59); performing the service at the site (transaction); enter into the computer fourth information associated with the performed service (transaction data is stored in the data table, e.g., task or item description, code, type, cost C.9, L.43-C.10, L.19); causing the computer to store fifth information associated with the service recipient, upon completion of the service (the salesperson or professional enters job finished data upon completion of the service, e.g., C.26, Table 5); transferring the date and/or time data, the identification information, and fourth information to the



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relational database (the accumulated transaction data has means of being transferred to a remote computer C.2, L.17-20 and 60-63); and, updating data and information stored on the relational database (Sussman discloses means of retrieving, editing, deleting, and outputting data C.3, L.21-24).

Sussman lacks the step of the computer having means for sensing the location of the provider and means for sensing a biometric property of the provider.

Katz discloses a handheld computer device that a provider (employee) uses. The Katz device includes an employee tracking system with means for sensing location of a provider (location sensor C.14, L.44) in order to avoid inaccurate or fraudulent reporting of employee time and attendance. Katz also discloses that means for sensing biometric data (e.g., voice recognition C.1, L.62; fingerprint C.2, L.65 to C.3, L.11) of a provider are known.

It would have been obvious to modify Sussman to include means for sensing location of the provider, such as taught by Katz, in order to avoid inaccurate or fraudulent reporting by the provider. It would have been further obvious to modify Sussman to include means for sensing biometric property of the provider, such as taught by Katz, in order to ensure that the device is not used by anyone but the provider.

Further, Sussman lacks the step of causing the computer to store the second information and/or third information when the provider activates the biometric sensing means and storing identification information associated with the provider's activation of the biometric sensing means. The examiner takes official notice that the timing of various events is a well-known computer developer/user preference and lies within the

level of ordinary skill in the computer storage field of endeavor. Therefore, it would have been obvious to one of ordinary skill to store the identification information after the provider has successfully identified by the computer in order to ensure timely storage of information and to avoid unauthorized access to information.

Sussman also lacks the step of determining whether the identification information and performed service information match information previously stored. The examiner takes official notice that the use of a computer to compare data within a database is a well-known expedient to find errors or inconsistencies and overwrite old information with new information. Therefore, it would have been obvious to one of ordinary skill in the art to further modify the Sussman and Katz combination to include the step of determining an information match in order to find errors and inconsistencies and retain the newest information.

b. Regarding claims 2 and 3, Sussman discloses a device that is capable of input and output of information. Mere substitution of one means of input-output for another does not render the claimed subject matter patentable. The examiner takes official notice that facsimile is a type of input-output data equivalent to keystroke entry or transfer of data. Therefore, it would have been obvious to one of ordinary skill in the art to modify the Sussman and Katz combination to include a facsimile request that is converted to an electronic image representation, in order to enter the service request into the computer system.

c. Regarding claim 4, Sussman discloses transmitting information via electrical/optical interface (C.2, L.17-20). Sussman is silent as to the particular type of

electrical/optical interface. The examiner takes official notice that a web-browser is a well-known user interface for quickly transferring data via a network. It would have been obvious to one of ordinary skill in the art to modify the Sussman and Katz combination to include a web-browser interface in order to transfer desired information more quickly.

d. Regarding claim 5, the recitation “the identifying information” has been interpreted as the previously recited first information.

The Sussman database is a relational database, i.e., tables of information. The relational database of the Sussman and Katz combination inherently links the information in various tables without the use of pointers.

e. Regarding claims 8 and 9, the recitation “the means for tracking” has been interpreted as the previously recited means for sensing the location.

The Sussman and Katz combination includes means for sensing the location (Katz location sensor C.14, L.44), as discussed with regard to claim 1 above, that is integral with the handheld device.

f. Regarding claim 10, the recitation “the performed service information” has been interpreted as the previously recited fourth information. The claim has been interpreted as further limiting the entering step of claim 1.

The Sussman and Katz combination includes entering information with the assistance of programmed prompts. For example, Sussman discloses the use of programmed tables and menus, as depicted in Fig.6, for entering data.

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g. Regarding claims 11-12, the Sussman and Katz combination includes means for sensing biometric data, as discussed with regard to claim 1 above, see C.2, L.65 to C.3, L.11 of Katz. The reference is silent as to the means for sensing biometric information being integral with the provider's computer. The examiner takes official notice that in the computer field of endeavor, the use of integral components rather than external components is a well-known expedient that is used in order to avoid losing external components or damaging external components that are exposed to unnecessary wear and tear.

Therefore, it would have been obvious to modify the means for sensing biometric information of the provider's computer as disclosed in the Sussman and Katz combination, to be integral with the computer to avoid losing or unnecessary wear and tear on the means for sensing biometric information.

h. Regarding claim 13, the recitation "the tracking means" has been interpreted as the previously recited means for sensing the location. The term "biometric sensor" as recited at line 4, has been interpreted as "biometric sensing means." The combination as claimed in claim 13 is discussed with respect to claims 8 and 11 above. The Sussman and Katz combination is silent as to whether the components are hot-swappable. The examiner takes official notice that it was known in the computer field at the time the invention was made, to provide components that are capable of hot swapping in order to avoid damage or spark hazard to the component or device. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify

the Sussman and Katz combination to include hot-swappable components in order to avoid damage or spark hazard to the component.

i. Regarding claim 17, the recitation “out of normal” has been interpreted to mean that which is described at P.10, L.11-23 of the specification because the term “out of normal data” lacks antecedent basis, i.e., is not clearly defined in the specification.

The Sussman and Katz combination includes generating a request for missing information insofar as the combination includes entering information with the assistance of programmed prompts. For example, Sussman discloses the use of programmed tables and menus, as depicted in Fig.6, for entering data. The combination includes preparing a report for out of normal data for example expected call that did not occur (C.5, L.22).

j. Regarding claims 19-22, Sussman discloses the step of providing professional services generally. The step of performing the service at the site may be any service requested, including election, census, checking equipment, verifying prescription.

k. Regarding claim 23, the recitation “the identifying information” has been interpreted as the previously recited first information. The Sussman and Katz combination includes services performed by a professional, which would include a physician, and the use of fingerprint identification (see discussion regarding claim 1 above).

l. Regarding claims 24 and 25, the examiner takes official notice that scannable and magnetic biometric identification means were known expedients for collecting and storing biometric information at the time of applicant’s invention. The use of scannable and magnetic capture devices enables the information to be easily transferred to a

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computer database for storage and future retrieval. It would have been obvious to one of ordinary skill at the time the invention was made to use scannable and magnetic biometric identification means to easily transfer the biometric information collected, stored, and retrieved.

m. Regarding claim 33, Sussman includes means for providing an alarm, as depicted in Fig.6d.

n. Regarding claim 38, Sussman discloses transmitting information via electrical/optical interface (C.2, L.17-20). Sussman is silent as to the particular type of electrical/optical interface. The examiner takes official notice that broadband transmission is a well-known user interface for quickly transferring data via a network. It would have been obvious to one of ordinary skill in the art to modify the Sussman and Katz combination to include broadband transmission interface in order to transfer desired information more quickly.

o. Regarding claim 39, it is inherent that the database of the Sussman and Katz combination includes a computer to perform the determining step, as broadly recited.

p. Regarding claim 40, Sussman lacks the step of analyzing the data and information transferred to the database. Katz teaches the step of analyzing data and information by way of generating reports 26 (C.5, L.16+). It would have been obvious to include the step of analyzing the data and information as recited in claim 40 by generating various reports.

q. Regarding claim 41, Sussman lacks the step of evaluating the data and information transferred to the database. Katz teaches the step of evaluating data and

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information by way of generating reports 26 (C.5, L.16+). It would have been obvious to include the step of evaluating the data and information as recited in claim 40 by generating various reports.

r. Regarding claim 42, line 23, the recitation, "the completed service" has been interpreted as the previously recited performed service.

Sussman discloses a system including means for generating a request for service (client task C.2, L.16); a relational database an account associated with the request and having information about the provider and the service (client table Ref.RAM3 10 and task table RAM2 9 and data table RAM1 8); means for assigning an individual provider to perform service (Sussman discloses that the portable device may be used by salespeople who sell services or professional people); means for providing, to a carryable computer associated with the provider (the salesperson or professional carries the device), information associated the site (client telephone number and/or address C.3, L.65-68), and information required to render the service (client task data table RAM2 9); means storing date and/or time data when the provider arrives at the site (data table RAM1 8 / date time field Ref.37 is automatically updated and transactions are stamped with the date C.10, L.55-59); means for storing information about the site (C.3, L.65-68); means for storing information associated with the performed service (transaction data is stored in the data table, e.g., task or item description, code, type, cost C.9, L.43-C.10, L.19); means for storing information about services previously rendered (client task data table RAM2 9); means for storing information associated with the service recipient, upon completion of the service (the salesperson or professional enters job finished data upon completion of

the service, e.g., C.26, Table 5); means for transferring the date and/or time data, the identification information, and information associated with the completed service to the relational database (the accumulated transaction data has means of being transferred to a remote computer C.2, L.17-20 and 60-63); and, means for updating data and information stored on the relational database (Sussman discloses means of retrieving, editing, deleting, and outputting data C.3, L.21-24).

Sussman lacks means for tracking the location of the provider, means for sensing a biometric property of the provider, and means for activating the biometric property sensing means.

Katz discloses a handheld computer device that a provider (employee) uses. The Katz device includes means for tracking the location of a provider (location sensor C.14, L.44) in order to avoid inaccurate or fraudulent reporting of employee time and attendance. Katz also discloses means for sensing biometric data (e.g., voice recognition C.1, L.62; fingerprint C.2, L.65 to C.3, L.11) of a provider. Katz inherently includes means for activating the biometric sensing means, whether it is turning on the computer or engaging the biometric to the means for sensing or some equivalent means.

It would have been obvious to modify Sussman to include means for tracking the location of the provider, such as taught by Katz, in order to avoid inaccurate or fraudulent reporting by the provider. It would have been further obvious to modify Sussman to include means for sensing biometric property of the provider and means for activating the biometric sensing means, such as taught by Katz, in order to ensure that the device is not used by anyone but the provider.



Further, Sussman lacks means for storing information when the provider activates the biometric sensing means and storing identification information associated with the provider's activation of the biometric sensing means. The examiner takes official notice that the timing of various events is a well-known computer developer/user preference and lies within the level of ordinary skill in the computer storage field of endeavor.

Therefore, it would have been obvious to one of ordinary skill to store the identification information after the provider has successfully identified by the computer in order to ensure timely storage of information and to avoid unauthorized access to information.

Sussman also lacks the means for determining whether the information transferred into the relational database matches stored information. The examiner takes official notice that the use of a computer to compare data within a database is a well-known expedient to find errors or inconsistencies and overwrite old information with new information. Therefore, it would have been obvious to one of ordinary skill in the art to further modify the Sussman and Katz combination to include means for determining whether information transferred matches stored information in order to find errors and inconsistencies and retain the newest information.

15. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sussman (US-4961158) and Katz (US-5963912) as applied to claim 1 above, and further in view of Kraftson (US-6151581).

a. Regarding claim 6, the claim has been treated as further limiting the providing step of claim 1. Sussman, as modified by Katz, discloses an electrical or optical interface. Sussman is silent as to the particulars of the electrical/optical connection.

Kraftson teaches the use of a synchronized connection in order to transfer data from one device to another (C.20, L.4-8). It would have been obvious to modify the Sussman and Katz combination to include providing information via a synchronized connection, such as suggested by Kraftson, in order to transfer data between the portable and nonportable device.

b. Regarding claim 7, Sussman discloses an electrical or optical interface. The examiner takes official notice that providing information via wireless interface in order to avoid cumbersome physical connections to a computer system, in particular, when using a portable device, was known at the time of the invention. Therefore, it would have been obvious to one of ordinary skill in the art to modify the Sussman and Katz combination to include a wireless interface in order to permit use of portable devices without having to physically connect the portable device to the network or computer for downloading information.

16. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sussman (US-4961158) and Katz (US-5963912) as applied to claim 1 above, and further in view of Peterson (US-5903873).

The Sussman and Katz combination discloses the accumulated transaction data has means of being transferred to a remote computer, see Sussman C.2, L.17-20 and 60-63. However, the particular means for transferring is not discussed. Peterson teaches the use of a modem 24 for transferring data from one device to another. It would have been obvious to one of ordinary skill in the art to further modify the Sussman and Katz

combination to include a modem link, such as suggested by Peterson, for transferring information.

17. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sussman (US-4961158) and Katz (US-5963912) as applied to claim 1 above, and further in view of Battaglia (US-6658202).

Battaglia teaches transferring data including the steps of verifying data transfer integrity and deleting the data from the source after it transferred to the new database in order to free space in the source for storing other data or information.

It would have been obvious to modify the transferring step of the Sussman and Katz combination to include the steps of verifying transfer integrity and deleting the data from the source computer after it is transferred to the relational database because hand held storage space is limited and once integrity of the data transferred has been verified the original source of the data may be deleted to free space in the source computer for storing other data or information.

18. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sussman (US-4961158) and Katz (US-5963912) as applied to claim 17 above, and further in view of Edelson (US-5737539).

Edelson teaches the use of an audit trail (the host computer ... provide an audit trail of access to the ... record C.15, L.29-54) for patient records. The method provides for retrieval of the original information and the changes. The computer audit trail provides a type of security and an archive of who did what when. It would have been obvious to one of ordinary skill in the art to modify the Sussman and Katz combination to

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include an audit trail, such as suggested by Edelson, in order to provide security of the records and an archive of who did what when.

19. Claims 26-32 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sussman (US-4961158) and Katz (US-5963912) as applied to claim 1 above, and further in view of Chen (US-5553609).

Regarding claims 26-32 and 34-37, Chen teaches the use of the computer structure recited in the claims. However, the examiner notes that the structure recited in the method claims has been given very little patentable weight insofar as the structure is not manipulated by the method. There is no method step recited which requires the computer structure as claimed in claims 26-32 and 34-37.

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Loosmore (US-5682142) discloses a tag node system for "checking" the location medical equipment.
- Johnson (US-6067525) discloses a portable computer used for tracking a salesperson's time with a customer, and storing a customer's order.
- Cooper article, Telemedicine is coming of age, discloses radiologists performing services remotely using a teleradiology device.
- Starkey (US-6745200) discloses work to be done by providers and produces a task sheet with information associated with the service site.

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21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (703) 305-1918.


The examiner can normally be reached on Monday - Friday from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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